

REMARKS

Reconsideration and allowance are respectfully requested in light of the above amendments and the following remarks.

Claims 1-10 are pending. Claim 5 is amended herein to correct typographical errors by striking out periods. No new matter has been added and no new issues are being presented.

Claims 1-3 and 6-8 stand rejected under 35 USC § 102(b) as anticipated by JP 09-092279. Claims 4 and 5 stand rejected under 35 USC 103(a) as unpatentable over JP 09-092279 and USPN 6,136,473 to Furukawa et al. The Applicants respectfully traverse.

The Final Rejection quotes an excerpt from JP 09-092279, provided by Applicants in the Amendment of July 11, 2003. Before the quote, the Final Rejection states, "Applicant [sic] provides a translation of Japanese Publication No. 09-092279." The Applicants did not provide a full translation of the reference. In fact, only two paragraphs therefrom were translated.

Moreover, after the quote, the Final Rejection mischaracterizes Applicants' arguments. Specifically, the Final Rejection states that Applicants' "arguments are largely directed to pointing to the process by which the Yb2O3 [sic] was formed." However, Applicants did not provide the translation to show or

argue how the ytterbium oxide, i.e.,  $\text{Yb}_2\text{O}_3$ , was formed, but for how the ytterbium oxide was treated. Thus, the excerpted section from JP '279 shows that the ytterbium oxide is added to the nickel hydroxide powder, cobalt, cobalt oxide, water and thickener without any treatment to form the paste from which the positive electrode is formed.

Regarding the rejection of claims 1-3 and 6-8 under 35 USC § 102(b) as anticipated by JP '279, the Final Rejection asserts, without citing specific portions of the reference, that JP '279 teaches each feature recited by the rejected claims. Initially, it is noted that the numbered paragraphs under this section of the Final Rejection are not complete sentences, as neither a subject nor predicate are present, and are confused. Applicants respectfully request clarification of the Final Rejection.

Applicants respectfully submit that the features recited in the product-by-process format of the present claims describe a material differing in structure from that of the cited references. As described throughout the specification, the rare earth compound (e.g., rare earth hydroxide precursors) of the present claimed invention formed by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent have disordered crystalline structures, in contrast to the structures

of conventional rare earth hydroxides. Further, the rare earth compound formed by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent are also coordinated with an alkali or water molecule; this is a characteristic not found in conventional rare earth hydroxides, which have not been formed by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent. See application page 8, line 20 to page 9, line 5.

Further, the rare earth compound formed by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent differs from conventional rare earth oxides and hydroxides based on weight. While the rare earth compound of the present invention exhibits a change in weight upon heating to a temperature as low as 100°C, conventional hydroxides require heating to around 200-300°C, and conventional oxides do not exhibit any weight change up to 400°C. This distinction occurs because of the presence of water, which is driven off at about 100°C when the compound of the present claimed invention is heated. See application page 9, lines 18-28.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested. If this rejection is maintained, the Examiner is respectfully requested, as required

by MPEP § 2131, to particularly point out where JP '279 expressly teaches each feature recited by each of claims 1-10, by for example, identifying the column and line where the teachings can be found, and providing an English-language translation thereof.

Regarding the rejection of claims 4 and 5 under 35 USC § 103(a) as unpatentable JP '279 and Furukawa et al. (U.S. Patent No. 6,136,473), it is noted that the statement of this rejection is unclear as it is replete with incomplete sentences. Clarification is respectfully requested.

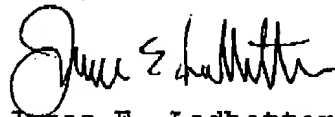
The Final Rejection apparently asserts JP '279 teaches each feature recited by these claims, except for the rare earth compound being both a yttrium-lutetium compound and a ytterbium-lutetium compound, and "the two compounds (Y/Yb-Lu) meet  $50 \geq X \geq 5$ , when weight of the yttrium (or ytterbium) compound and the lutetium compound are  $(100-x)\%$  weight and  $X\%$  by weight, respectively," for which purpose it is possible the Final Rejection asserts Furukawa et al. However, Furukawa et al. fail to cure the above-noted deficiencies of JP '279 and thus claims 4 and 5 cannot be rendered obvious by the teachings of these references.

In light of the foregoing, it is respectfully submitted that all rejections are overcome and that all pending claims are

directed to allowable subject matter. Thus, Applicants respectfully request entry of the amendment and passage of this application to allowance.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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